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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/164,777 10/01/98 MULLOR

M REINC4237.01

EXAMINER

TM01/0622

SPENCER AND FRANK  
SUITE 300 EAST  
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WASHINGTON DC 20005-3955

HEWITT II, C  
ART UNIT PAPER NUMBER

2161

DATE MAILED:

06/22/01

7

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

*[Handwritten signature]*

# Office Action Summary

Application No.

09/164,777

Applicant(s)

MULLOR ET AL.

Examiner

Calvin L Hewitt II

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

*Status of Claims*

1. Claims 1-13 and 16-20 have been examined.

*Response to Arguments and Amendment*

2. The Applicants are of the opinion that the Ginter et al. reference is insufficient as it is believed that it does not teach, "... setting up a verification structure and verifying the program using the verification structure". The Examiner will focus his comments to this matter as other comments regarding the intended use of the claimed invention (e.g. "stationary object" vs. "travelling object") do not result in a structural difference between the claimed invention and the prior art. And, if the prior art structure is capable of performing the intended use, then it meets the claim- See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). To this end, the Examiner would like to reiterate that Ginter et al. the system of Ginter et al. supports, "launchable content" (column/line 24/54-25/27) and maintains, and allows for evolving, content and content control as it passes through a "chain of handling" (column/line 28/42-32/60).

Regarding verification structure, Ginter et al. create for each VDE object a permission record (PERC) (column/line 93/5-94/4; column/line 155/38-159/12) that "...

controls how access and/or manipulation permissions are distributed and/or how content and/or other information may otherwise be used (column 155, lines 46-51). Ginter et al teach that electronic appliances may include one or more SPUs (column 64, lines 1-4) and may be a standardized feature on microprocessors (column 65, lines 17-55). As previously stated, the SPU contains, volatile and non-volatile memories (column/line 70/11-71/15; column/line 71/51-72/67). The SPU Internal ROM contains, "...kernel programs, load modules and encryption key information [that] enable the control of certain basic functions of the SPU" and "... components that are at least in part dependent on [device configuration] may be loaded in [ROM] along with additional load modules that have been determined to be required for specific installations or applications (column 70, lines 48-53). Further, Ginter et al. teach that SPU hardware, provides at least enough processing capabilities to support the secure parts of processing such as events that generate a usage permission (figure 3; column 58, lines 22-49; column 60, lines 45-55). Therefore, the Examiner regards the generation of usage permissions as basic to a SPU, hence, the appropriate load modules would be present in the ROM or EEPROM (column 70, lines 54-65) to allow for such minimum processing. Also, Ginter et al. teach that content control information follows the content (e.g. PERC) therefore, it is inherent that PERC-relevant data would be stored in non-volatile memory (relying on the standard definition of "non-volatile" memory as memory that is maintained even when the power is removed from the storage system). Finally, the Examiner takes issue with the Applicant using EEPROM to store a license record including author name, program name

and number of licensed users. The Applicant has not disclosed the necessary hardware to allow a user to add, remove and modify a license record stored in an EEPROM.

EEPROM is read-only memory. Therefore the ability to update existing and add new records to data stored in the EEPROM is contradictory.

*Claim Rejections - 35 USC § 112*

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not support the Applicants' claim of using non-erasable, non-volatile memory being used to store license records.

Claims 2-19 are also rejected as they depend from claim 1.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant refers to secondary non-volatile storage as EEPROM (Specification, page 8, lines 1 and 25-27). However, EEPROMs require a special or programmer voltage to program it, store 0's and 1's, are programmed at the factory and

when erased all data is removed. The Applicants do not teach the device necessary to edit an EEPROM nor have they made it clear to the Examiner how their system would be implemented in light of the non-trivial processing required to write and erase its data.

Claims 2-19 are also rejected as they depend from claim 1.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A device to write to an EEPROM and a method taking into account said device are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Applicants do not teach the device necessary to edit an EEPROM nor have they made it clear to the Examiner how their system would be implemented in light of the non-trivial processing required to write and erase its data.

Claims 2-19 are also rejected as they depend from claim 1.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "non-volatile" in claim 1 is used by

the claim to exclude "hard disk," while it is accepted that a "hard disk" is "non-volatile" as it does not lose data when the power is removed from it.

Claims 2-19 are also rejected as they depend from claim 1.

8. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the encrypting of the pseudo unique key.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4, 6 and 10-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ginter et al. U.S. Patent No. 5,892,900.

As per claim 1, Ginter et al. teach of a system and method for secure transactions management and electronic rights protection that:

- restricts software operation within a license limitation (column 5, lines 29-41; column 6, lines 29-65; column 7, lines 45-57)

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- utilizes a computer that has a first non-volatile memory column/line 70/45-71-16; column/line 71/52-72/67; column 231, lines 13-32; column 236, lines 43-53; column 240, lines 7-42; column 241, lines 19-30; column/line 245/55-246/24), a second non-volatile memory area (column/line 70/45-71-16; column/line 71/52-72/67; column 231, lines 13-32; column 236, lines 43-53; column 240, lines 7-42; column 241, lines 19-30; column/line 245/55-246/24) and a volatile memory area (column 71, lines 12-25)
- provides a means of selecting a program residing in the volatile memory (column 71, lines 25-27 and column 82, lines 12-52)
- sets up a verification structure in the non-volatile memories (column 70, lines 23-53 and column/line 63/67-64/15)
- verifies the program using the structure (column 70, lines 23-53 and column/line 63/67-64/15)
- acts on the program according to the verification (column 70, lines 23-53 and column/line 63/67-64/15).

As per claim 2, the method and system of Ginter et al. provide for a license authorization bureau in the form of a VDE (virtual distribution environment) distributor and/or administrator (column/line 278/40 to 281/44).

As per claim 3, the method and system of Ginter et al. discloses a verification method with a license authorization bureau that comprises of:



- a two-way data communication link between said bureau and end-user computer (figure 77)
- a method for establishing end-user rights (column/line 278/40 to 281/44)
- data encryption using keys (column 281, lines 10-22)
- creating a license record from the selected program at the bureau (column 15, lines 10-34; column 71, lines 25-27, column 82, lines 12-52, column/line 278/40 to 281/44 ).

As per claim 4, the method and system of Ginter et al. also provides a means of encrypting the license record for the selected program from the second volatile memory (column/line 65/55 to 66/47).

As per claim 6, the method and system of Ginter et al. provides a means for establishing a licensed software program. Where said program contains license record data and is found in the volatile memory (column 71, lines 25-27, column 82, lines 12-52, column/line 278/40 to 281/44, column 15, lines 10-34, figure 8 and column 96, lines 37-41).

As per claim 10, the method and system of Ginter et al. provide a means for restricting a program's operation with predetermined limitations if the authorization is invalid (column 279, lines 21-32).

As per claim 11, the method and system of Ginter et al. provide for a ROM BIOS (figure 69G and column 70, lines 39-53).

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As per claim 12, the method and system of Ginter et al. provide for an EEPROM BIOS (figure 69G and column 70, lines 54-65).

As per claim 13, the method and system of Ginter et al. provide for volatile RAM (column 71, lines 22-25).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5 and 7-9 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. U.S. Patent No. 5,892,900 as applied to claims 1, 3, 4 and 6 above, and further in view of Goldman et al. 5,684,951.

As per claim 5 and 16-20, Ginter et al. disclose a verification structure. In addition, Ginter et al. disclose a system and method for secure transaction management and electronic rights protection utilizing encryption keys (column 15, lines 35-60; column/line 45/3-46/26; column 49, lines 47-52; column 206, lines 57-65). Ginter et al. also teach unique keys and storing keys in non-volatile memory (column/line 21/60-22/25; column/line 70/45-71-16; column/line 71/52-72/67). However, Ginter et al. do not disclose pseudo unique keys. Goldman et al. teach of a method and system for user

authorization over a multi-user computer system. In said system, a user has valid id but lacks an authorized means of access. In order to access the desired data, a user is sent a pseudo unique key (abstract, lines 19-21) that is derived from a user id and the current IP address. Therefore, it would have been obvious to a person of ordinary skill in the art of encryption, to incorporate pseudo unique keys into the system of Ginter et al. By utilizing such a method a valid user can be provided access to secured data without comprising the security of the larger system. It would have also been obvious to encrypt communications using pseudo unique keys if less secure means of data exchange was deemed appropriate.

As per claim 7, Ginter et al. teach of a method and system for electronic rights protection comprising of volatile memory, non-volatile memory, license records location and licensed software programs (column 5, lines 29-41; column 6, lines 29-65; column 15, lines 10-34; column/line 63/67-64/15; column/line 65/55-66-47; column 70, lines 23-65; column 71, lines 12-27; column 96, lines 37-41; column/line 278/40-281/44). Ginter et al. also use encryption keys (column 206, lines 57-65). However, Ginter et al. do not make use of pseudo unique keys in their system. Goldman et al. teach of a method and system for user authorization over a multi-user computer system through the use of pseudo unique keys (abstract, lines 19-23). In said system, a user has valid id but lacks an authorized means of access. In order to access the desired data, a user is sent a pseudo unique key that is derived from a user id and the current IP address. Therefore, it would have been obvious to a person of ordinary skill in the art of the time the invention was made to utilize pseudo unique keys in the system of Ginter et al.. By utilizing such a

method a valid user can be provided access to secured data without comprising the security of the larger system.

As per claim 8, Ginter et al. disclose a method for authoring content that includes encryption keys (column/line 282/ 33 to 283/34). Ginter et al. disclose a method for selecting a licensed software program from the volatile memory to form a license record. However, Ginter et al. do not use pseudo unique keys for purposes of encryption.

Goldman et al. teach of a method and system for user authorization over a multi-user computer system through the use of pseudo unique keys (abstract, lines 19-23). In said system, a user has valid id but lacks an authorized means of access. In order to access the desired data, a user is sent a pseudo unique key that is derived from a user id and the current IP address. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use pseudo unique keys. By utilizing such a method a valid user can be provided access to secured data without comprising the security of the larger system. In addition, it would have also been obvious to encrypt communications using pseudo unique keys if less secure means of data exchange was deemed appropriate.

As per claim 9, Ginter et al. teach of a system and method for encrypting and decrypting of licensing related communications between end-user(s) and a license authorization bureau (column/line 282/33 to 283/34 and 168/25 to 169/40). Ginter et al. also teach of volatile and non-volatile memory areas used in conjunction with licensed software programs (figure 8; column 15, lines 10-34; columns 70-72, column 82, lines

12-52, , column/line 70/45-71-16; column/line 71/52-72/67; column 96, lines 37-41; column 231, lines 13-32; column 236, lines 43-53; column 240, lines 7-42; column 241, lines 19-30; column/line 245/55-246/24; column/line 278/40-281/44). However, Ginter et al. do not disclose pseudo unique keys. Goldman et al. provide for the use of pseudo unique keys (abstract, 19-23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made, to incorporate pseudo unique keys into the system of Ginter et al.. By utilizing such a method a valid user can be provided access to secured data without comprising the security of the larger system.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Richardson, III teaches a system for software protection

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 305-0625. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

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(703) 308-5397 (for informal or draft communications, please label

“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should  
be directed to the Group receptionist whose telephone number is (703) 305-3900.

Calvin Loyd Hewitt II

June 21, 2001

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100